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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,989	12/18/2000	Jaan Noolandi	D/A0489Q	4290
7590		02/16/2006	EXAMINER	
John E. Beck		DAWSON, GLENN K		
Xerox Corporation		ART UNIT		
Xerox Square-20A		PAPER NUMBER		
Rochester, NY 14644		3731		

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/739,989

Applicant(s)

NOOLANDI ET AL.

Examiner

Glenn K. Dawson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3,6-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,622,720 in view of Zesch-6200491 and Sweet-5231426.

The claims of the patent claim the invention as claimed, including a reservoir of a pharmaceutical product which receives energy from a plurality of lenses; the energy produced by a supply and a plurality of driver transducers and the distance from a top surface of the lens to a surface of the pharmaceutical product is less than 150 micrometers. However, the product is claimed, not the process of using the product; one driver energizing a plurality of lenses is not claimed, and the type of lenses is not claimed. However, Zesh discloses that it was known to energize a plurality of lenses

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with a single transducer. It would have been obvious to have provided the claimed device with a plurality of transducers, each driving an array of lenses, as merely being an obvious duplication of known parts, and because using a single transducer to drive more than one lens greatly simplifies, and lessens the cost of the manufacturing of the device. Since the product claims all include functional use (intended process of using the product) which is consistent with the process claims of the application, it would have been obvious to have claimed the intended manner in which the product was to be used. Sweet discloses the use of fresnel lenses. Any known acoustic lenses would have been obvious, including fresnel or spherical molded plastic lenses bonded to a plastic substrate, as merely known alternatives capable of producing the required energy wave focusing to produce droplets.

Claim 4 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6622720 in view of Ryder-5415161.

Patent no. 6622720 discloses the invention as claimed with the exception of the duration of the energy pulse and the positioning of the device relative to the patient's orifice. Ryder discloses that it was known to gate an inhalation therapy device to deliver medication only during an inhalation. It would have been obvious to have provided the pulse to the transducer for less than 5 seconds, as it has been shown by Ryder that it was known to provide medication only during inspiration. As inspiration would be less than 5 seconds, to have provided a pulse of less than 5 seconds (less than the duration of an inspiration) would have been obvious to reduce the waste of medication.

Positioning the device within 4 inches of the orifice would have been obvious to ensure that the droplets produced by the device would be breathed.

Claims 15,17 and 18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6622720 in view of Ryder-5415161.

Claim 19 includes all of the limitations of the claimed process using functional or intended use statements, except they are in a product claim, not a process claim. However, since the process limitations are clearly the intended use, and since they mirror the application's process claims, it would have been obvious to have claimed the process of using the claimed product. The claims of the patent fail to claim the pulse duration. Ryder discloses that it was known to gate an inhalation therapy device to deliver medication only during an inhalation. It would have been obvious to have provided the pulse to the transducer for less than 5 seconds, as it has been shown by Ryder that it was known to provide medication only during inspiration. As inspiration would be less than 5 seconds, to have provided a pulse of less than 5 seconds (less than the duration of an inspiration) would have been obvious to reduce the waste of medication.

Response to Arguments

Applicant's arguments with respect to claims 1-4,6-15,17 and 18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Glenn K Dawson
Primary Examiner
Art Unit 3731

Gkd
13 February 2006